

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	85027343
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 109
<b>MARK SECTION (no change)</b>	
<b>EVIDENCE SECTION</b>	
<b>EVIDENCE FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_389824798-191645804_.VERUS_Request_for_Reconsideration.pdf</a>
<b>CONVERTED PDF FILE(S) (8 pages)</b>	<a href="#">\\TICRS\EXPORT11\IMAGEOUT11\850\273\85027343\xml7\RFR0002.JPG</a>
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<b>ORIGINAL PDF FILE</b>	<a href="#">evi_389824798-191645804_.Dec_of_Steve_Earhart_20110919.pdf</a>
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<b>DESCRIPTION OF EVIDENCE FILE</b>	Request for Reconsideration Written Argument and supporting Declaration (Exhibit A).
<b>SIGNATURE SECTION</b>	

<b>RESPONSE SIGNATURE</b>	/Kristine L. Butler/
<b>SIGNATORY'S NAME</b>	Kristine L. Butler
<b>SIGNATORY'S POSITION</b>	Attorney of record, NJ bar member
<b>DATE SIGNED</b>	09/19/2011
<b>AUTHORIZED SIGNATORY</b>	YES
<b>CONCURRENT APPEAL NOTICE FILED</b>	NO
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Mon Sep 19 19:22:10 EDT 2011
<b>TEAS STAMP</b>	USPTO/RFR-38.98.247.98-20 110919192210103869-850273 43-480f9ff50a8f2c4c1ff185 25439b12b32-N/A-N/A-20110 919191645804022

## Request for Reconsideration after Final Action To the Commissioner for Trademarks:

Application serial no. **85027343** has been amended as follows:

### EVIDENCE

Evidence in the nature of Request for Reconsideration Written Argument and supporting Declaration (Exhibit A). has been attached.

#### Original PDF file:

[evi\\_389824798-191645804 . VERUS Request for Reconsideration.pdf](#)

#### Converted PDF file(s) (8 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

#### Original PDF file:

[evi\\_389824798-191645804 . Dec of Steve Earhart 20110919.pdf](#)

**Converted PDF file(s)** (4 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

## **SIGNATURE(S)**

### **Request for Reconsideration Signature**

Signature: /Kristine L. Butler/ Date: 09/19/2011

Signatory's Name: Kristine L. Butler

Signatory's Position: Attorney of record, NJ bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85027343

Internet Transmission Date: Mon Sep 19 19:22:10 EDT 2011

TEAS Stamp: USPTO/RFR-38.98.247.98-20110919192210103

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**TRADEMARK**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE IN RE <b>TRADEMARK APPLICATION</b>	
Applicant: Verus Underwriting Managers, LLC <b>U.S. Serial No.: 85/027,343</b> <b>Filed: April 30, 2010</b> Mark: VERUS UNDERWRITING MANAGERS	Trademark Atty: Tracy Cross Law Office: 109  Our File: WRB11-TM001

**REQUEST FOR RECONSIDERATION**

This Request for Reconsideration is filed in response to the Final Office Action mailed on March 19, 2011 in connection with the above-captioned application, and is submitted concurrently with Applicant's Notice of Appeal.

**REMARKS**

The Examining Attorney has issued a final refusal under Section 2(d) of the Lanham Act of Applicant's VERUS UNDERWRITING MANAGERS Trademark in view of U.S. Registration No. 2513476 for the mark "VERUS HEALTH" and U.S. Registration No. 2618301 for the mark "VERUS HEALTH AUTHENTIC HEALTH INSURANCE" & Design (hereinafter "cited Marks"). Both registrations are for "health insurance plan administration," and both registrations are owned by Registrant, Verus Health LLC LTD. LIAB Co. in Indianapolis, Indiana.

In support of this Request for Reconsideration, Applicant submits the Declaration of Steven P. Earhart, Vice President Chief Financial Officer of Verus Underwriting Managers, LLC ("Declaration," Exhibit A). As outlined in greater detail below, Applicant respectfully submits that there is no likelihood of confusion between Applicant's Mark and the Cited Marks.

**I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN APPLICANT'S MARK AND THE CITED MARKS**

**A. The Services Offered Under Applicant's Mark Are Not Similar to Those Offered Under the Cited Marks**

As outlined in the concurrently submitted Declaration, Applicant's services are for "insurance underwriting and administration in the fields of property, casualty, and workers' compensation; risk management services," which are clearly distinct from Registrant's health insurance plan administration services ("Cited Services"). Applicant's Services are offered to particular consumers, who are sophisticated. In addition, Applicant's Services are the type of services that require careful consideration before purchasing.

Businesses interested in property, casualty, and workers' compensation insurance have very specific needs that are different from the needs of an individual. A good deal of thought and consideration goes into the selection of property, casualty, and workers' compensation insurance. *Id.* at ¶ 3.

Property, casualty, and workers' compensation insurance services such as those provided in connection with the "VERUS UNDERWRITING MANAGERS" service mark are often provided to businesses through insurance brokers who try and meet the specific needs of their clients. *Id.* at ¶ 4. Such brokers are sophisticated clientele. *Id.*

The Cited Services, health insurance plan administration services, are distinct services from insurance underwriting and administration in the fields of property, casualty, and workers' compensation; risk management services. *Id.* at ¶6. Health insurance plan administration services is directed to a completely different field and different customer than commercial casualty

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insurance, property or workers' compensation insurance. Declaration at ¶6. A relevant client or consumer seeking insurance underwriting and administration in the fields of property, casualty, and workers' compensation; risk management services would readily distinguish between those types of insurance and health insurance plan administration services, as these services serve completely different purposes. *Id.* at ¶7.

Accordingly, Applicant's Services and the Cited Services are significantly different. A relevant client or consumer seeking property, casualty, and workers' compensation insurance and risk management services would readily distinguish between that type of insurance and health insurance plan administration services as the two serve completely different purposes. *Id.* at ¶7.

It appears the Examiner believes that the services under Applicant's "ADMIRAL EXCESS EXPRESS" Mark and the Cited Services used in connection with the Cited Mark are comparable, merely because the services could be broadly categorized to be "provided in the insurance field." However, such a generalization when comparing goods and/or services is impermissible. As the Board stated in *UMC Industries, Inc. v. UMC Electronics Co.*, 207 U.S.P.Q. 861, 879 (T.T.A.B. 1980), "the fact that one term, such as 'electronic,' may be found which generically describes the goods of both parties is manifestly insufficient to establish that the goods are related in any meaningful way." (Emphasis added; internal citations omitted). *See also, Lenox Inc. v. Ranmaru U.S.A. Corp.*, 17 U.S.P.Q.2d 1696, 1701 (S.D.N.Y. 1990) (although marks identical, considering plaintiff's fine china against defendant's casual dinnerware, "[t]he closeness of the products, however, begins and ends with their shared membership in the plate family").

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As the parties' services at issue here are intended for completely different purposes, confusion is not likely. Even where marks are much more similar than Applicant's Mark and the Cited Mark, where the goods or services differ, there is no likelihood of confusion. *Victor Adding Machine Co. v. General Dynamics Corp.*, 124 U.S.P.Q. 5421, 522 (T.T.A.B. 1960) (confusion not likely between "DIGIMATIC" for combined mathematical computer and controller for machine tools, and "DIGI-MATIC" for solenoid actuated adding and calculating machines; goods "intended for completely different purposes").

For example, in *In re Massey-Ferguson Inc.*, 222 U.S.P.Q. 367 (T.T.A.B. 1983), the Board considered whether confusion was likely between the virtually identical marks "E-COM" for parts order services in the field of farm and industrial machinery and providing parts availability, location and routing information by means of a computer, and "ECOM" for magnetic core memory systems for electrical computers and data processing systems. In finding no likelihood of confusion, and reversing the Examining Attorney's 2(d) refusal, the Board noted the differences in the goods at issue:

While it is not impossible that a farmer familiar with computer components, upon seeing "E-COM" on applicant's computer terminal when he goes to his tractor dealership to get a replacement part for his farm tractor, could associate the terminal used to locate and order the part with the magnetic core memory systems identified by the mark "ECOM", we do not think it is likely. The statute, specifically Section 2(d), supports refusal of registration only where confusion, mistake or deception is likely. The court in *Witco Chemical Company v. Whitfield Chemical Company, Inc.*, 164 U.S.P.Q. 43 (C.C.P.A. 1969) at page 44, noted that in resolving a conflict under Section 2(d),

We are not concerned with mere theoretical possibilities of confusion, deception or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

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In the case at hand the differences between the goods of the registrant and the services of the applicant are simply too great, even though the marks are almost identical, for confusion to be more than a remote possibility. [Emphasis supplied.]

In each of the cases cited herein, the marks were effectively identical, and the goods or services could be generally characterized as related. Yet, in each case, the differences between the goods and/or services upon closer examination resulted in the recognition that confusion was unlikely.

Moreover, consumers of Applicant's Services are sophisticated commercial businesses or brokers, and the services at issue can be quite expensive. In such instances, confusion is not likely. In an analogous case, *Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575, 217 U.S.P.Q. 649 (Fed. Cir. 1983), the Federal Circuit affirmed the Board's conclusion that "because the marks are used on goods that are 'quite different' and sold to different, discriminating customers, there is no likelihood of confusion" even though both parties used the identical mark "DRC." 217 U.S.P.Q. at 649.

It has long been held that "[s]ophisticated consumers may be expected to exercise greater care." *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 U.S.P.Q. 2d (BNA) 1388, 1392 (Fed. Cir. 1992), (citation omitted). "[T]here is always less likelihood of confusion where goods are expensive and purchased after careful consideration." *Id.*

Applicant acknowledges that the Examining Attorney attached copies of third-party registrations of marks to suggest that health insurance administration and underwriting for property and casualty insurance are of a kind that may emanate from a single source. However, again, the clientele that is purchasing these services will exhibit particular care in making their



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purchase. *See In re Ship*, 4 U.S.P.Q.2d 1174, 1176 (TTAB 1987) (“We are of the opinion that these dry cleaning professionals are likely to be aware of practices in the dry cleaning industry, are likely to be aware of the source of commercial dry cleaning equipment and are likely to know that a dry cleaning establishment offering laundry and dry cleaning services is not likely to be the source of commercial dry cleaning equipment, even where such services and goods are offered under virtually identical marks.”) Manifestly, it is possible to find registrations directed to many different services, but that does not reflect the "real world" possibility of confusion or the true nature of the relatedness of the goods or services.

Moreover, the Cited Marks lists a date of first use of November 1, 2000. Applicant's Mark has been in use since at least 2010. During that time period, Applicant is not aware of a single instance of actual confusion. Declaration, ¶ 8. This factor also weighs in favor of Applicant.

Sharing one term, "VERUS", cannot alone lead to a finding of a likelihood of consumer confusion. However, the terms other than "VERUS", as with Applicant's Mark, dispel any potential confusion.

In every case turning on likelihood of confusion, "it is the duty of the examiner, the board and this court to find, upon consideration of all the evidence, whether or not confusion appears likely." *In re E.I. Dupont DeNemours & Co.*, 177 U.S.P.Q. 563, 568 (C.C.P.A. 1973). Accordingly, several factors exist and must be considered demonstrating that confusion is not likely between Applicant's Mark and the Cited Marks.

## **II. THE MARKS MUST BE CONSIDERED IN THEIR ENTIRETIES**

Although the Examining Attorney has recognized that trademarks must be compared in their entirety, the Examining Attorney did not follow that mandate in comparing the marks at issue here.

The terms "UNDERWRITING MANAGERS" in Applicant's Mark are, of course, not present in the Cited Marks. Those terms in Applicant's Mark, when read together, create a distinctive phonetic impression that is completely absent from the Cited Marks. Thus, when considered in their entirety, the marks are not confusingly similar.

No likelihood of confusion has been found for marks much more similar than the marks considered herein, for much more closely related goods. *See, e.g., In re Blanchard Importing & Distributing Co., Inc.*, 149 U.S.P.Q. (BNA) 699 (C.C.P.A. 1966) ("CANADIAN CHAMP" is not so similar to "CHAMPION" that confusion is likely, both for whiskey); *Sears, Roebuck and Co. v. Hofman*, 119 U.S.P.Q. (BNA) 137 (C.C.P.A. 1958) ("ROYAL PLUMAGE" is not likely to be confused with "ROYAL PURPLE", both for apparel); *Medicated Products Co. v. Alice Jewelry Company*, 118 U.S.P.Q. (BNA) 90 (C.C.P.A. 1958) (Confusion is not likely from concurrent use of "THE BRIDAL PAIR" and "BRIDE'S PRIDE", both for jewelry); *Hardwick Manufacturing Co., Inc. v. Ejecto Corporation*, 169 U.S.P.Q. (BNA) 747 (T.T.A.B. 1971) (difference between "EJECT CONTROL" and "EJECT-ALL," when considered in their entirety, high cost of goods and care which would normally be exercised in purchase thereof, Board concludes that contemporaneous use of marks is not likely to cause confusion).

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Considering the differences between Applicant's Mark and the Cited Marks in the respective marks and the services, confusion is not likely under Section 2(d), and the refusal to register should be withdrawn.

**II. CONCLUSION**

In view of the foregoing remarks, Applicant respectfully requests that the final refusal be withdrawn, and the application be passed to publication, and in due course, registration. If there are any final modifications or changes required by the Examining Attorney, the Examining Attorney is respectfully requested to contact the undersigned directly by telephone at 215-255-9196 or by email at [kbutler@vklaw.com](mailto:kbutler@vklaw.com).

# **EXHIBIT A**

## TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE IN RE <b>TRADEMARK APPLICATION</b>	
Applicant: Verus Underwriting Managers, LLC <b>U.S. Serial No.: 85/027,343</b> <b>Filed: April 30, 2010</b> Mark: VERUS UNDERWRITING MANAGERS	Trademark Atty: Tracy Cross Law Office: 109  Our File: WRB11-TM001

### DECLARATION

I, Steven P. Earheart, hereby declare as follows:

1. I am Vice President Chief Financial Officer of Verus Underwriting Managers, LLC, Applicant in connection with the above-captioned trademark application, and I am authorized to make this Declaration on behalf of Applicant.

2. Since at least 2010, the service mark "VERUS UNDERWRITING MANAGERS" has been used by Applicant in connection with insurance underwriting and administration in the fields of property, casualty, and workers' compensation; risk management services.

3. Businesses interested in property, casualty, and workers' compensation insurance have very specific needs that are different from the needs of an individual. A good deal of thought and consideration goes into the selection of property, casualty, and workers' compensation insurance.

4. Property, casualty, and workers' compensation services such as those provided in connection with the "VERUS UNDERWRITING MANAGERS" service mark are often provided to businesses through insurance brokers who try and meet the specific needs of their clients. In my experience, such brokers are sophisticated clientele.

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5. It is my understanding that Applicant's "VERUS UNDERWRITING MANAGERS" service mark application has been refused registration in view of the trademark "VERUS HEALTH" and "VERUS HEALTH AUTHENTIC HEALTH INSURANCE" & Design for health insurance plan administration services.

6. Health insurance plan administration services are distinct services from insurance underwriting and administration in the fields of property, casualty, and workers' compensation; risk management services. Health insurance plan administration services is directed to a completely different field and different customer than commercial casualty insurance, property or workers' compensation insurance.

7. A relevant client or consumer seeking insurance underwriting and administration in the fields of property, casualty, and workers' compensation; risk management services would readily distinguish between those types of insurance and health insurance plan administration services, as these services serve completely different purposes.

8. I am aware of no incidents of actual confusion between the use of the service mark "VERUS UNDERWRITING MANAGERS" by Applicant for Applicant's services, and the use of the marks "VERUS HEALTH" and/or "VERUS HEALTH AUTHENTIC HEALTH INSURANCE" & Design used for Health insurance plan administration services.

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9. I have been hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration.

VERUS UNDERWRITING  
MANAGERS, LLC

By:



Name: Steven P. Earhart

Title: Vice President Chief  
Financial Officer

Date:

